

## II. REMARKS

Applicants have reviewed the Office action mailed September 5, 2002 and fully address herein the following objections and rejection contained therein.

Sections II and III of the Office action recite a number of issues that are neither rejections of nor objections to the claims of the instant application. Applicants address Sections II and III of the Office action below, but note that the issues raised are not relevant to the patentability of the claims in this application. For this reason, Sections II and III of the Office action are improper and should therefore be withdrawn in their entireties.

Section III of the Office action is followed by Sections IV-VI that assert the following objections to and rejections of the pending claims and drawings.

In Section IV the Examiner objects to the drawings under 37 C.F.R. § 1.83(a).

In Section V.1, claims 10, 11, 13 and 14 were rejected under 35 U.S.C. § 112, first paragraph, as containing new matter and/or subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Section V.2, claims 10, 11, 13 and 14 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Section VI, claims 10, 11, 13 and 14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In Section VII, claims 10, 11, 13 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Saeki et al.

Applicants reply herein to each ground of objection and rejection presented in the Office action. Applicants hereby request reconsideration and further examination of the instant application.

#### A. Response To Sections II & III Of The Office Action.

Sections II and III of the Office action discuss a list of 30 “Examples” of issues that have been raised in some of applicants’ copending applications. The Examiner alleges that in some cases applicants have “handled and addressed” these issues inconsistently in different applications. The Examiner states that the list of “Examples” will be maintained by the Patent Office “in an attempt to ensure consistency in the way that these issues are handled between applications in the future.” Office action, p. 3.

Applicants respectfully submit that the “Examples” are simply irrelevant to the prosecution of the instant application for a number of reasons. The Examiner in Section II has acknowledged that the list of 30 Examples is not relevant to certain applications because applicants have not asserted priority in those applications to the filing date of applicants’ 1981 application:

It is examiners position that after a series of interview, it has been mutually agreed upon that the instant application is entitled the earlier priority date of 9/11/87 based on the 07/096,096 application and not the 11/3/81 date based on the 06/317,510 application. Therefore, the written description and the enablement under 112 1<sup>st</sup> paragraph should be limited to the 1987 specification only. Additionally, the remarks set forth in Paragraph III, items 1-30 [the “Examples”] of the instant office action are carried over from other office actions in similar cases and are presented herein because in the past there have been disagreements between the priority date that the applicants are entitled to. The examiner will withdraw paragraph III from subsequent actions in the instant case application if applicants confirm on record in the next communication that the instant application is entitled to only the 1987 priority date and the citations for claim support will be only provided for the 1987 specification.

The Examiner’s position that he will withdraw the irrelevant 30 Examples only if “applicants confirm on record in the next communication that the instant application is entitled to only the 1987 priority date” is improper. Whether or not *a particular claim* is afforded the benefit of an earlier filing date under § 120 simply depends on whether the requirements of § 120 are met *for that claim*. A claim either is or is not entitled to an earlier filing date, and such a determination cannot be made without conducting the appropriate claim-by-claim analysis required by the controlling authorities.

Of course, it is applicants' decision whether or not to invoke § 120 in order to overcome an intervening reference. In the instant application, applicants have distinguished the teachings of the intervening reference applied by the Examiner on the merits and have *not* invoked § 120 to avoid the intervening reference. Moreover, applicants have demonstrated specification support below only with respect to the 1987 specification. Accordingly, the 30 Examples should be withdrawn.

Applicants question the relevance of the 30 Examples, as well as applicants' need to respond to these Examples, because none of the examples forms the basis for any objection to or rejection of a pending claim. *See 37 C.F.R. § 1.111* ("In order to be entitled to reconsideration or further examination, the applicant . . . must reply to every ground of objection and rejection in the prior Office action."). Further, none of the Examples even refers to any claims that are presently pending in the instant application. Accordingly, the 30 Examples simply have no bearing on the prosecution of the claims pending in the instant application, and are therefore improper.

Applicants further question the basis for including the 30 Examples in the instant application and applicants' need to respond to the Examples, because the vast majority of the Examples have appeared at least once before in other applications and because applicants have already responded to the vast majority of the Examples on the record in their copending applications. For example, all 30 Examples appear in identical form in the 07/17/02 Office action received in application Ser. No. 08/470,571 ("the '571 Application"). Additionally, at least 20 of the current Examples previously appeared in the 08/28/01 Office action in the '571 Application. Accordingly, applicants, in their 01/28/02 and 01/09/03 Responses filed in the '571 Application, have already fully responded on the record to all of the 30 Examples listed in the instant application.

In addition to the identical "Examples" being repeated from other recent Office actions, applicants note that many of the issues discussed in the 30 Examples have been raised by the Examiner before in slightly different forms in applicants' various copending applications. In addressing such issues, applicants have at all times strived to respond in a consistent manner in all of applicants' copending applications. Accordingly, applicants believe that the Examiner is mistaken in

his assertion that applicants have “handled and addressed” the issues raised in the 30 Examples “inconsistently.”

The 30 Examples are not relevant to the instant application, and applicants respectfully request that the Examples be withdrawn and that the Examiner acknowledge the lack of relevance of the 30 Examples to the prosecution of the instant application. Notwithstanding applicants’ position regarding the lack of relevance of the 30 Examples to the prosecution of the instant case, applicants provide the following responses<sup>1</sup> to the 30 Examples. Applicants reserve their right to further address any of the 30 Examples if, for example, they are ever raised in the context of an actual rejection or objection.

### **Examples 1-3**

Examples 1-3 address various issues concerning applicants’ ability to claim priority to their 1981 application and the proper test for demonstrating priority under 35 U.S.C. § 120. Because applicants have not asserted priority to their 1981 application for any of the pending claims in the instant application, Examples 1-3 are wholly irrelevant to the instant application.

In Example 1, the Examiner discusses prosecution of applicants’ copending application Ser. No. 08/470,571. More specifically, the Examiner focuses on the need to first demonstrate written description support in applicants’ 1987 specification when claiming priority under § 120. Applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application, and applicants have identified detailed written description support in their 1987 specification for each and every pending claim in the instant application in Appendix B. Further, applicants respectfully disagree with the Examiner’s characterization of their position regarding priority in their copending applications. Finally, in addition to being totally irrelevant to the instant application, applicants submit that the assertions made by the Examiner in Example 1 are

---

<sup>1</sup> More detailed responses to many of the Examples appear in, among other places, applicants’ 01/28/02 Response, 05/06/02 Response to Interview Summary, and 01/09/03 Response filed in the ‘571 Application.

improper in the absence of any priority claim made by applicants under 35 U.S.C. § 120 to their 1981 application for any claim in the instant application.

In Example 2, the Examiner takes issue with applicants' discussion and position regarding the proper test for demonstrating priority under § 120. Again, the Examiner refers to applicants' responses filed in the '571 Application. Although applicants continue to disagree with the Examiner's description and application of the legal test for demonstrating priority under § 120 (for the detailed reasons set forth by applicants, e.g., in their 01/09/03 Response in the '571 Application), the issue of priority under § 120 is simply not an issue in the instant application.

In Example 3, the Examiner further discusses applicants' ability to demonstrate priority under § 120 and their ability to support claims pending in the '571 Application using applicants' 1987 specification. Applicants believe that the issues raised in Example 3 are irrelevant to the instant application and submit that the Examiner has mischaracterized applicants' position regarding their ability to demonstrate written description support in both the 1987 and 1981 specifications for the claims pending in the '571 Application and other applications in which applicants are asserting priority under § 120.

Applicants' positions with respect to the various issues related to applicants' ability to claim priority to the date of their 1981 specification and the proper legal test for demonstrating priority under § 120 has been discussed in detail in applicants' submissions in the '571 Application. Applicants will continue to provide the factual and legal bases that justify their claim of priority to their 1981 application in those copending applications where such claim is appropriate and necessary (i.e., if intervening art is applied and applicants elect to invoke § 120 to overcome such intervening art).

#### **Example 4**

In Example 4, the Examiner discusses a claim limitation (i.e., "locally generating" images) relevant to certain claims pending in applicants' '571 Application. Applicants respectfully disagree with the Examiner's assertion in Example 4 that Teletext decoders locally generate images for output

or display in the same manner that is being claimed in certain ones of applicants' copending applications, and applicants have already addressed the issue of whether the prior art applied by the Examiner teaches local generation of images in the '571 Application. If the Examiner bases a rejection of or objection to any claim pending in the instant application on the issues found in Example 4, or asserts that the issues found in Example 4 are in any way relevant to the instant application, applicants will address any such assertions at the appropriate time.

### **Examples 5 and 27**

In Examples 5 and 27, the Examiner discusses the "Teletext prior art" and the inventions disclosed in applicants' 1987 specification in the context of an Office action and a Response filed in the '571 Application. The Examiner asserts in Examples 5 and 27 that applicants' 1987 "packetized SPAM" structure represents little more than applicants' own version of a "conventional extended Teletext system." In Example 27, the Examiner further asserts that certain structures recited in some of applicants' claims pending in the '571 Application (namely, a receiver, a signal detector, a processor, and an output device) are also "found within a conventional CPU/MP/computer implemented Teletext" receiver. These examples are not discussed or applied in the context of any of the claims pending in the instant application and the Examiner does not reject any of the pending claims based on the arguments made in Examples 5 and 27. If and when the Examiner makes rejections of specific pending claims on the basis of issues raised in Examples 5 and 27, applicants will further respond to such a rejection. Notwithstanding the lack of relevance of Examples 5 and 27 to this application, applicants strenuously disagree with the Examiner's disparaging assertions and characterization of the subject matter disclosed in applicants' 1987 specification. Finally, applicants note that they have previously addressed how applicants' claims differ from many "Teletext" prior art references in prior responses filed in copending applications.

### **Example 6**

In Example 6, the Examiner discusses applicants' ability to obtain priority to their 1981 filing date for claiming "computer software." The Examiner discusses this issue with respect to arguments

advanced in applicants' '571 Application related to applicants' prior use of the term "programming" in claims pending in the '571 Application. Applicants have fully addressed the issues raised in Example 6 in the '571 Application. The issues raised in Example 6, however, are not relevant to the instant application because applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application. In fact, in Example 6, the Examiner acknowledges that applicants' 1987 specification does disclose the downloading of computer software. Notwithstanding the lack of relevance of Example 6 to this application, applicants disagree with the Examiner's position regarding applicants' ability to obtain priority to their 1981 filing date for claims that include the term "programming."

### **Example 7**

In Example 7, the Examiner alleges that Teletext decoders found in the prior art are "signal processors" as the term "signal processor" is used within the context of applicants' claims pending in the '571 Application. Again, the issues raised in Example 7 are not discussed in the context of any claim currently pending in the instant application. Applicants do not understand the relevance of Example 7 to any of the claims currently pending in the instant application and no attempt is made to apply the discussion in Example 7 to the instant claims. Notwithstanding the lack of relevance of Example 7 to this application, applicants respectfully disagree with the Examiner's assertions and characterization of Teletext decoders found in the prior art and the signal processor disclosed by applicants. Applicants submit that the signal processors disclosed in applicants' specifications perform functions that are not disclosed in the cited Teletext prior art references. Finally, applicants will address these issues if and when an actual rejection is made by the Examiner based on the issues raised in Example 7.

### **Example 8**

In Example 8, the Examiner asserts that it is applicants' position that applicants' claimed/disclosed technology is not "correlated/analogous" to Teletext technology. The Examiner, however, fails to provide any details regarding his position that "conventional Teletext systems"

generally are correlated or similar to applicants' claimed technology. Indeed, such generalized "correlations" or "analogies" are wholly irrelevant to the issue of whether or not applicants' claims are patentable. Applicants' position is that none of the specific references, related to Teletext or otherwise, alone or in combination, teach the methods and apparatus claimed by applicants. The Examiner further argues that applicants have previously indicated it is their belief that the scope of many of their pending claims encompasses the "Weather Star" system/receiver technology. First, the question of whether or not a particular system would be covered by a pending claim is wholly irrelevant to the examination of the instant claims, unless such system is prior art. The Examiner has not established that the Weather Star system is prior art. Second, although the Examiner vaguely refers to applicants' "pending amended claims," he makes no reference to a specific application *or a specific claim*. Due to the Examiner's broad treatment of these issues, applicants cannot respond in any meaningful manner to the issues raised in Example 8.

#### **Example 9**

In Example 9, the Examiner discusses an issue that arose in the prosecution of the '571 Application regarding whether "digital television signals/programming" was well known in the relevant art at the time that applicants filed their specifications. In their 1/28/02 Response filed in the '571 Application, applicants fully addressed the Examiner's rejections under § 112, second paragraph, of claims with limitations of "digital television." Further, applicants maintain their position stated in the '571 Application regarding the Schwartz et al. reference. Applicants note that there are no rejections of or objections to any of applicants' pending claims in the instant application based on the issues raised in Example 9, and applicants reserve the right to further respond to the issues raised in Example 9 if any of these assertions are relied on to object to or reject any claim in the future.

#### **Example 10**

In Example 10, the Examiner discusses two references of Zaboklicki: DE 2,914,981 and GB#2,016,874. Despite the Examiner's characterization of applicants' arguments regarding these

references, applicants maintain that neither Zaboklicki reference anticipates or renders obvious any of applicants' pending claims in the instant application. Applicants have previously addressed issues raised in Example 10 in the '571 Application, and applicants will continue to address in detail any rejection under § 102 or § 103 in which a Zaboklicki reference is applied.

### **Examples 11, 12, 15 and 16**

In Examples 11, 12, 15 and 16, the Examiner discusses applicants' use of the term "programming" in the 1981 and 1987 specifications. More specifically, Examples 11, 12, 15 and 16 assert that applicants cannot claim a 1981 priority date for claims including the term "computer programming," because of an allegedly narrow definition of that term in the 1981 specification. The issues raised in Examples 11, 12, 15 and 16 are only relevant if applicants rely on § 120 to obtain the benefit of their 1981 filing date. As applicants have not claimed priority to their 1981 application for any claims currently pending in this application, the issue is not relevant to the instant application. If and when the Examiner asserts that the issues found in Examples 11, 12, 15 and 16 are relevant to the claims pending in the instant application, applicants will respond at the appropriate time. Finally, applicants have fully addressed the "programming" issues raised in these examples in several prior responses filed in the '571 Application.

### **Example 13**

In Example 13, the Examiner discusses whether or not radio and television arts represent non-analogous arts. The Examiner states that applicants have previously asserted that the radio and television arts are non-analogous arts. The Examiner's assertions in Example 13 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 13 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim based on specific applied references in the identified arts.

### **Example 14**

In Example 14, the Examiner discusses issues related to a claim recitation (simultaneous and sequential) in the context of two of applicants' copending applications (i.e., the '571 Application and Application Ser. No. 08/469,078. The Examiner's assertions in Example 14 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 14 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Additionally, applicants note that they have fully addressed issues related to the Examiner's concerns regarding "simultaneous and sequential" in their January 28, 2002 Response filed in the '571 Application.

### **Examples 17-20 and 23-26**

Examples 17-20 and 23-26 discuss various issues related to applicants' ability to obtain a priority date based on their 1981 application and the proper legal test to be applied when analyzing an applicants' ability to obtain a priority date under § 120. None of the issues discussed in Examples 17-20 and 23-26 is relevant to the instant application because applicants have not asserted a 1981 priority date for the claims pending in the instant application. Further, applicants have addressed the issues related to priority in detail in their responses filed in the '571 Application and Application Ser. No. 08/487,526.

### **Example 21**

In Example 21, the Examiner describes and compares the technology disclosed by applicants in their 1981 and 1987 specifications and asserts that the technology disclosed in applicants' two specifications is "vastly different." While it is true that the 1987 application includes many enhancements and improvements, applicants maintain that the subject matter disclosed in their 1981 application is also disclosed in the 1987 application. Second, because applicants have not asserted a 1981 priority date for the claims pending in the instant application, applicants' 1981 specification and any comparison between applicants' 1981 and 1987 specifications are not relevant to the instant

application. Finally, the issues raised in Example 21 have previously been addressed in the ‘571 Application. Applicants will continue to provide appropriate factual and legal arguments as to why they are entitled to a 1981 priority date in all cases where it is relevant.

### **Example 22**

In Example 22, the Examiner discusses a perceived difficulty in interpreting terminology in applicants’ claims in light of the 1981 and 1987 specifications. More specifically, the Examiner asserts that certain terminology in applicants’ claims takes on different interpretations when such terminology is read on different teachings from applicants’ 1981 and 1987 disclosures. The alleged “problem” described in Example 22 is simply not applicable to the instant application because applicants have not asserted a priority date based on their 1981 application for any claim pending in the instant application. In the instant application, only the 1987 specification is used to support the pending claims. Accordingly, the issues raised by the Examiner in Example 22 are not relevant to the instant application. Further, applicants have fully addressed Example 22 in the ‘571 Application.

### **Example 28**

In Example 28, the Examiner discusses a specific claim pending in the ‘571 Application (claim 56). Specifically, the Examiner questions applicants’ written description support for the recitation “interactive ultimate receiver station” previously appearing in claim 56 of the ‘571 Application. Applicants maintain that both the 1981 and 1987 specifications unquestionably disclose “interactive receiver stations.” *See, e.g.,* 1981 Specification col. 20, ll. 23-27, and “Local Input” in Figure 6D; 1987 Specification, p. 288, ll. 1-20. The Examiner’s assertions in Example 28 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 28 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Finally, applicants note that they have already fully addressed Example 28 in the ‘571 Application.

### **Example 29**

Example 29 discusses limitations directed to combining images (e.g., where a “portion” of an image is “replaced” by a portion of another image) which are allegedly present in claims in applicants’ ‘571 Application. Applicants maintain that applicants’ specifications broadly teach the combining of images. The Examiner’s assertions in Example 29 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 29 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Further, applicants have already fully addressed the issues raised in Example 29 in the ‘571 Application.

### **Example 30**

In Example 30, the Examiner discusses the publication date of article/reference by Gunn et al. Applicants acknowledge that the Gunn reference is a transcript from a conference in London that took place from March 26-28, 1980. But this information alone does not qualify the reference as prior art (i.e., it was unclear when the paper was published). However, since the mailing of the 7/17/02 Office action in the ‘571 Application, applicants received a copy of the Gunn reference that bears a Massachusetts Institute of Technology Library received stamp dated December 4, 1980. The Examiner also alleges in Example 30 that applicants have previously neglected to provide the Office with information regarding the publication dates of many references. Applicants have diligently supplied the Office with references as they have become known to applicants. In some instances, applicants were not provided with dates of certain references, so applicants were not able to provide the Office with dates for each and every reference identified on some of applicants’ Information Disclosure Statements. Additionally, applicants submit that the discussion in Example 30 is not relevant to the instant application because the Gunn reference is not applied against any claim pending in the instant application.

## B. Response To Section IV Of The Office Action: Objection To Drawings.

In Section IV, the drawings are objected to under 37 C.F.R. § 1.83(a). Title 35 U.S.C. § 113 states that the applicant shall furnish a drawing *where necessary* for the understanding of the subject matter sought. Corresponding Rule 1.81(a) sets forth that the applicant for a patent is required to furnish a drawing of his or her invention *where necessary* for the understanding of the subject matter sought to be patented. Applicants initially note that the claims in this application are directed to methods of delivering programming. A full understanding of this invention is obtained from the specification as discussed below. A drawing is not necessary for the understanding of the subject matter sought to be patented. Applicants have, however, provided detailed drawings that depict the apparatus and the signal structure that may be employed to practice the claimed methods, as discussed below. Applicants submit that these drawings are more than sufficient to satisfy the provisions of 35 U.S.C. § 113 and 37 C.F.R. §§ 1.81 and 1.83.

The Examiner has provided no guidance regarding what additional drawings would be desired to provide a clearer understanding of the claimed invention. Rather, a list is provided of claimed “features” that are alleged to be absent from the drawings. There is no explanation of how the drawings fail to show these “features,” why such “features” must be shown in the drawings for an understanding of the claimed subject matter (to the extent such “features” are not shown), or how the Examiner expects such “features” to be illustrated.

Specifically, the Examiner states that the following claimed “features” are not shown in the drawings: “specific combined medium programming;” “interactive mass medium [program] output apparatus;” “first combined medium programming;” “first” and “second portions of combined medium programming;” and “computer output of the combined medium programming.” Figure 7 clearly depicts the recited “interactive mass medium output apparatus” (see especially local input, 225, satellite receiver circuitry, 251, cable converter box, 222, signal processor, 200, microcomputer, 205, monitor, 202, printer, 221, and speaker system, 263). Of the remaining terms questioned by the Examiner, only “first combined medium programming” is still in the claims. In addition, the amended claims now recite the terms “interactive combined medium programming output

apparatus" (also clearly depicted in Fig. 7; see above), "mass medium programming," "first" and "second user specific programming," "portion of said first user specific programming," "subscriber's own information," "portion of said subscriber's own information," "first" and "second subscriber specific information," "programming," "portion of combined medium programming," and "preference information."

Applicants' drawings clearly show how such "first combined medium programming," "mass medium programming," "first" and "second user specific programming," "portion of said first user specific programming," "subscriber's own information," "portion of said subscriber's own information," "first" and "second subscriber specific information," "programming," "portion of combined medium programming," and "preference information" are communicated within and among the various components used in connection with applicants' invention (see, e.g., Figs. 6A, 6B, & 7). Moreover, applicants have shown in the drawings the specific components (e.g., television tuner, 215, microcomputer, 205, controller, 12, decoder, 203, processor, 200, monitor, 202, radio, 209, printer, 221, speaker system, 263, and other output apparatus, 261; see, e.g., Figs. 1, 2D, 3, 4, 6A, 6B, 7, & 7E) that utilize, present and/or process the recited instructions, signals, programming, and information. Applicants submit that the depiction of these components, and the interconnections therebetween, are more than sufficient to satisfy any drawing requirement with respect to various types of "programming," "instructions," "information," or "signals."

Accordingly, applicants submit that all drawing requirements have been met. Thus, applicants respectfully request that the objection under 37 C.F.R. § 1.83(a) be withdrawn.

#### **C. Response To Section V.1 Of The Office Action: Section 112, First Paragraph (Written Description).**

The Examiner prefaces his rejections under § 112, first paragraph, by listing a series of quotations from a decision issued in prior litigation pending before the International Trade Commission (ITC) involving one of applicants' issued patents. In Section V.1, the Examiner simply lists several quotations and states that the Examiner "continues to adopt these same positions in

regard to the pending amended claims currently at issue." Apparently, the Examiner includes these quotations to support his rejections under § 112, first paragraph. The Examiner, however, fails to provide any discussion or explanation regarding the proper procedural and factual context of these quotes. Placed in an accurate and proper context, the record from the ITC litigation actually supports applicants' position that the pending claims are justified by the instant specification.

Before addressing the specific passages quoted in the Office action, applicants must first provide a procedural overview of the ITC litigation. In the litigation before the ITC, the owner of applicants' issued patents and the assignee of the instant application, Personalized Media Communications L.L.C. (PMC), alleged that certain products imported into the United States infringed several claims of U.S. Patent No. 5,225,277. Following an evidentiary hearing, the ITC administrative law judge, Judge Luckern, issued a decision entitled "Initial and Recommended Determinations" (Initial Determinations) on October 20, 1997. *See In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392, 1997 WL 696255 (Int'l Trade Comm'n Oct. 20, 1997). In connection with the evidentiary hearing, three separate groups submitted briefs and arguments to Judge Luckern: 1) PMC; 2) the accused infringers (Respondents); and 3) the ITC Staff. Judge Luckern's Initial Determinations made various findings and concluded that: 1) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as indefinite; 2) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as not enabled; 3) claim 7 was invalid as anticipated; and 4) no asserted claim was infringed. Significantly, the Respondents challenged only one claim, claim 44, for lack of written description support. Judge Luckern found that claim 44 was *not invalid* under § 112, first paragraph, for a failure to provide proper written description support. *Thus, no claim asserted in the ITC litigation was held invalid by Judge Luckern under 35-U.S.C. § 112, first paragraph, for failure to provide adequate written description support.*

On December 4, 1997, the ITC issued its Final Determination, which adopted some, but not all, of Judge Luckern's Initial Determinations. Specifically, the ITC's Final Determination adopted Judge Luckern's claim constructions and findings that the asserted claims were indefinite and not

infringed. On the other hand, the ITC did not adopt Judge Luckern's other findings concerning, for example, whether the claims were enabled or whether claim 7 was anticipated. On appeal before the Federal Circuit were only those findings by Judge Luckern that the ITC expressly adopted in its Final Determination. The Federal Circuit's opinion: 1) reversed Judge Luckern's and the ITC's determination that the asserted patents claims were invalid for indefiniteness; 2) vacated Judge Luckern's and the ITC's determination that asserted claim 7 was not infringed; and 3) affirmed Judge Luckern's and the ITC's determination that claims 6 and 44 were not infringed. *See Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998). As a result of the Federal Circuit opinion, the case was remanded to the ITC. After the case was remanded to the ITC, PMC withdrew its complaint and the ITC vacated Judge Luckern's Initial Determination with respect to the findings of invalidity for anticipation and lack of enablement. *See In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392, 2001 WL 535427 (Int'l Trade Comm'n May 13, 1999). Accordingly, the quotes relied upon by the Examiner in the Office action, all of which are from Judge Luckern's discussion of invalidity for lack of enablement, were vacated by the ITC.

As applicants have already noted, with respect to the only claim even challenged under the written description requirement of § 112, Judge Luckern concluded that the claim was *not invalid* on that basis.<sup>2</sup> Regarding the first quote, Judge Luckern's belief that the 1987 specification is "difficult to understand as it is dealing with many possible systems," even if true, is not a proper reason for the Examiner to conclude that none of applicants' claims are supported under § 112. Regarding the second quote, in which Judge Luckern discusses the complainant's identification of written description support for the asserted claims of U.S. Patent No. 5,225,277, what is important is that Judge Luckern did not find that any of the asserted claims were invalid for failure to satisfy the written description requirement of § 112. Finally, the last two quotes identified by the Examiner

---

<sup>2</sup> Additionally, in allowing the claims asserted in the ITC to issue, the PTO understood that those claims were adequately supported under § 112.

actually contain statements made by the ITC Staff in opening arguments. The comments advanced by the Staff in the ITC litigation describing “directions to a treasure map” and “ships passing in the night” are attorney arguments advanced during litigation, and such arguments are simply not indicative of applicants’ actions before the PTO.

When the Examiner’s citations to the ITC record are presented accurately and in their proper substantive and procedural context, the citations do not support the Examiner’s position. Indeed, the ITC record is consistent with applicants’ position on the written description issue. The statements relied upon by the Examiner are nothing more than dicta concerning a finding by Judge Luckern that was later vacated. Further, even if these findings had not been vacated, the observations by Judge Luckern do not contradict applicants’ position that the pending claims are properly supported under § 112, first paragraph.

The Examiner asserts that he has followed the “Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶1, “Written Description” Requirement, 66 Fed. Reg. 4 (2001). Applicants note that the eighth edition of the M.P.E.P. at section 2163 has been rewritten to incorporate these guidelines. *See* M.P.E.P. Summary of Changes (blue pages) at 37. Accordingly, applicants submit that the examination of this application should follow the guidelines as set forth in M.P.E.P. § 2163. The Examiner has not fully complied with these guidelines. Section 2163 III sets forth how the Examiner must clearly communicate his findings, conclusions, and their bases. These findings, in addition to merely identifying claim limitations, should:

Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

M.P.E.P. § 2163 III. A. (B). When appropriate, the Examiner should also suggest amendments to the claims which can be supported by the application’s written description. M.P.E.P. § 2163 III. A. The Examiner has not established a *prima facie* case as discussed below.

In Section V, the Examiner rejects all claims under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not sufficiently described in the specification. In making these rejections, however, the Examiner does nothing more than identify specific limitations pending in a given claim and state “the critical components and features called for in the claims are nowhere to be found either in the specification or in the drawing figures.” There is absolutely no analysis of, reference to, or discussion of any of the teachings found in applicants’ specification which disclose the claimed subject matter.

In the instant Response, applicants have provided a chart (attached as Appendix B) that identifies detailed written description support for each and every limitation of the pending claims. Applicants respectfully submit that the illustrative support identified in Appendix B, together with applicants’ narrative discussion below, demonstrates that the claimed subject matter is described in the specification in such a way as to reasonably convey to one skilled in the art that applicants had possession of the claimed inventions at the time the 1987 application was filed. Applicants wish to note that the support provided below and in Appendix B is illustrative and the claims may be supportable by other/additional teachings of the 1987 specification. Applicants also wish to note that the claims of the instant application should not be construed to be limited based on the support provided.

**1) “Farm Plans Of Europe” And “Exotic Meals Of India” Examples Provide Sufficient Written Description Support For Claims 10, 11, 13, 14, & 17-39**

The “Summary Example #11” detailing the “Farm Plans of Europe” (the “Farms Plans Example”) program beginning on page 533 of the Specification and the “Exotic Meals of India” (the “Exotic Meals Example”) beginning on page 469 provide written description support for the claims.

The “combined medium programming” is disclosed in the specification in the Farm Plans Example. A feature of the Farm Plans Example is to collect and aggregate continental, national, local and farm-specific agricultural and market data, and to communicate such processed continental, national, local and farm-specific information to farmers. In this way, optimal planting

plans can be generated for a specific farmer based on user-specific information such as farm size and soil conditions, as well as local and national information such as agricultural policy and market conditions. This is effected by a two-way exchange of information between and among the disclosed master transmission station, the national and local intermediate transmission stations (“ITS”), each farmer’s ultimate receiver station (“URS”), and the individual farmers themselves. The master station and national and local ITSs can all originate their own mass media programming.

The combined medium programming disclosed in the Farm Plan Example includes television programming of general interest (i.e., the recited “video”) as well as specific crop planting information applicable to specific farmers (p. 552, ll. 24-26). Because the combined medium programming includes both television programming of general interest as well as user-specific information, the presentation of combined medium programming disclosed in the Farm Plans Example properly supports the “combined medium programming” recited in the claims.

The television programming of general interest (including accompanying embedded signals) is transmitted from a master station to national and local ITSs, and finally to a particular farmer’s URS (p. 542 ll. 33 - 543, ll. 19), via satellite, cablecast, or other means (p. 12, ll. 21-22).

Communication with the farmer occurs through the farmer’s URS, which is an interactive output apparatus that includes both a television for displaying programming and a computer (p. 533, line 35 - p. 534, line 5). The URS has an input device and memory so that the farmer can input and store user-specific data at the URS (p. 555, ll. 19-29; p. 551, ll. 11-14). The computer also has the ability to process such user-specific data to generate farm-specific crop planting plans (p. 548, ll. 18-22). It can also transmit farm plan information so that the master station can receive and aggregate such information with similar data from other farms in other localities and nations (p. 555, line 24 - p. 556, line 6). By aggregating at the master level, the master transmission station can identify if current plans indicate, e.g., an over-production of a particular crop in a particular locality (p. 555, line 24 - p. 556, line 6). Such an overproduction would be reflected in the next transmission and calculation of specific crop plans (p. 556, ll. 12-16).

In the Exotic Meals Example, a central station broadcasts a television program of general interest entitled “Exotic Meals of India,” along with embedded SPAM control signals that enable computers at the individual subscriber stations to process subscriber data (p. 470, ll. 1-2; p. 59, ll. 29-33; p. 481, ll. 7-9). The subscriber station stores at its memory user specific information such as the taste preferences and size of the user’s family (p. 469, ll. 7-14; p. 493, line 33 - p. 494, line 8). During the Exotic Meals Example presentation, a television announcer asks the user to request a subscriber specific recipe and shopping list by inputting a code at the subscriber station input device (p. 471, ll. 6-13). The subscriber then inputs the code, and in response the subscriber station prints the recipe and shopping list at the receiver station printer (p. 475, ll. 1-2; see also p. 474, ll. 8-35). In generating the recipe and shopping list, the subscriber station computer tailors the recipe and shopping list to the taste preferences and size of the user’s family (p. 474, ll. 8-32).

**a) Support For Claim 10 And Claims Depending Therefrom**

Claim 10 recites “a method for delivering programming for use with an interactive mass medium program output apparatus.” The subscriber station of the Exotic Meals Example (pp. 469-516) is an interactive mass medium programming output apparatus. It has a television for outputting mass medium programming such as television programs (Fig. 7; p. 469, line 35 - p. 470, line 23). The receiver station is “interactive.” It has an input device for receiving inputs from subscribers (p. 471, ll. 16-18). Subscribers can enter information at the input device based on the outputted programming (p. 471, ll. 6-17). The subscriber station can also deliver programming based on the subscriber input (p. 474, ll. 2-7).

One step of the method includes “storing a subscriber’s own information at said interactive mass medium program output apparatus.” The subscriber station (interactive mass medium program output apparatus) stores information (subscriber’s own information) (p. 11, ll. 27-31) relating to the food preferences of a subscriber’s family, e.g., information specifying that the family prefers spicy food and prefers to minimize salt consumption (p. 469, ll. 7-17).

Claim 10 recites “outputting mass medium programming after said step of storing, said interactive mass medium output apparatus having an input device to receive input from said subscriber.” After the subscriber information is stored, the receiver station outputs mass medium television programming (p. 469, line 35 - p. 470, line 21). Each subscriber station is equipped with a keyboard (input device) to receive input from a subscriber (p. 471, ll. 14-18; Fig. 7).

Claim 10 recites “prompting said subscriber during said mass medium programming for first input.” Halfway through the television programming, the television program host requests subscribers interested in obtaining a recipe and shopping list to input “TV567#” at their subscriber station input device (p. 471, ll. 6-13).

Claim 10 recites “receiving first input from said subscriber at said input device in response to said prompting said subscriber, said first input indicating that said subscriber wants delivery of first user specific programming referred to in said mass medium programming.” In response to the program host’s request, the subscriber enters “TV567#” at the subscriber station keyboard to indicate that the subscriber wants to have a recipe and shopping list (programming referred to in said mass medium programming) delivered to the subscriber (p. 471, ll. 14-21; see also p. 471, ll. 6-13).

Claim 10 recites “delivering said first user specific programming at said interactive mass medium program output apparatus wherein said first user specific programming is based on said stored subscriber’s own information.” The subscriber station outputs recipe and shopping list information (user specific programming) at its printer (p. 475, ll. 1-2; see also p. 474, ll. 8-35). The recipe and shopping list are generated based on the subscriber’s food preferences (p. 474, ll. 8-32).

Claims 11, 17-28, and 39-42 depend from claim 10. The support for these claims is thus based upon the support discussed above in connection with claim 10. These claims set forth further features found in the specification. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

**b) Support For Claim 13 And Claims Depending Therefrom**

Claim 13 recites “a method for combined medium programming delivery for use with an interactive combined medium programming output apparatus.” The subscriber station of the Farm Plans Example is an interactive combined medium programming output apparatus. It has a television for outputting combined medium programming such as a television program combined with a user specific farm plan recommendation (Fig. 7; p. 533, p. 534, ll. 1-4; p. 538, ll. 15-29; p. 552, ll. 20-30). The receiver station is “interactive” (e.g., p. 538, ll. 15-18). It has an input device for receiving inputs from subscribers (p. 555, ll. 21-22). Subscribers can enter information at the input device based on the outputted programming (p. 555, ll. 14-23). The subscriber station can also deliver programming based on the subscriber input (p. 555, line 19 - p. 556, line 18).

As described above, the receiver station in the Farm Plans Example is an interactive combined medium programming output apparatus (Fig. 7; p. 533, line 35 - p. 534, line 5; p. 538, ll. 15-29; p. 555, ll. 14-23; p. 555, line 19 - p. 556, line 18). One step of the method recites “storing a subscriber’s own information at said interactive combined medium programming output apparatus” (p. 11, ll. 27-31). The subscriber station (interactive combined medium programming output apparatus) stores information relating to the subscriber’s farm (subscriber’s own information) (p. 11, ll. 17-21), including the number and size of the individual parcels of property of the subscriber’s farm and the farm equipment of the farmer (p. 534, ll. 5-14) and a specific crop planting plan (p. 551, ll. 11-14; p. 550, ll. 30-35).

Claim 13 recites “outputting first combined medium programming after said step of storing.” Pursuant to the Farm Plans Example presentation, the receiver stations store the subscriber’s information before the combined medium presentation begins (see Example #11 beginning on p. 533, e.g., p. 534, ll. 5-14; p. 548, ll. 23-27 indicating that the subscriber’s own farm information is “prerecorded”) (p. 550, ll. 30-35; p. 551, ll. 11-14). Thus, after the subscriber’s farm information is stored, the receiver station displays (outputs) combined medium programming on its monitor (p. 552, ll. 20-30). Claim 13 recites “said first combined medium programming comprising video of general interest and first subscriber specific information.” The combined medium programming

includes a regular television program entitled "Farm Plans of Europe" (video of general interest) and a crop plan (first subscriber specific information) based on the stored plan (p. 551, ll. 11-14) which has been tailored to an individual subscriber's farm based on the subscriber's particular stored crop information (p. 549, line 32 - p. 550, line 10; p. 552, ll. 20-30; p. 550, line 30 - p. 551, line 6). Claim 13 recites "said interactive combined medium programming output apparatus having an input device to receive input from said subscriber." The receiver station includes a keyboard (input device) to accept input from the subscriber (Fig. 7; p. 555, ll. 21-22).

Claim 13 recites "receiving input from said subscriber at said input device in response to said first combined medium programming." In response to the outputted recommended crop plan, the subscriber enters information (input) at the keyboard to modify the stored farm information (p. 555, ll. 14-23).

Claim 13 recites "delivering second combined medium programming at said interactive combined medium programming output apparatus, said second combined medium programming including second subscriber specific information based on said stored subscriber's own information and said input." The farm plan information (as modified by the subscriber if modified (p. 554, ll. 12-21)) is sent to a remote collection station and aggregated with similar farm plan information from other subscribers (p. 555, line 24 - p. 556, line 6). The aggregated data is used to refine and modify the national and regional variables that were used to calculate the subscriber's specific farm plan (p. 555, line 24 - p. 556, line 6). Finally, in a manner similar to the "outputting" step described above, the receiver station outputs a second segment of the Farm Plans of Europe television program and a second subscriber specific crop plan (collectively, second combined medium programming) (p. 556, ll. 12-16). The second subscriber specific crop plan is based on the stored farm information, such as the soil conditions and history of crop rotation (p. 556, ll. 12-16; p. 549, line 33 - p. 550, line 10). Further, the second subscriber specific crop plan is calculated using the new variables, which are based on the modified farm data (second subscriber specific information) of all the farmers (p. 556,

ll. 12-16). Although such feature is not claimed in claim 10, the second crop plan will be different from the first because it will be based on different market price projections (p. 556, ll. 3-6).

Claims 14 and 29-38 depend from claim 13. The support for these claims is thus based upon the support discussed above in connection with claim 13. These claims set forth further features found in the specification. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

**D. Response To Section V.2 Of The Office Action: Section 112, First Paragraph (Enablement).**

The Examiner at Section V, part 2, further rejects all claims under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Particularly, the Examiner alleges that the essential novelty, the essence of the invention, must be described with greater particularity than that exhibited in this application. Moreover, the Examiner asserts that nowhere in applicant's specification is contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Further, the Examiner suggests that under the circumstances, one of ordinary skill in the art would be burdened with undue experimentation in trying to make and use the claimed invention. p. 65. Applicants strongly disagree and traverse this rejection on the following grounds.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F. 2d 778, 785 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. MPEP § 2164.01 (citations omitted). The scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required.

MPEP § 2164.03. A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. *Id.* (citations omitted).

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557 (Fed. Cir. 1993). The minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. *In re Bowen*, 492 F.2d 859, 862-63 (CCPA 1974). MPEP § 2164.04 states:

The language [of the rejection] should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.

(Emphasis in original) This is followed by the explicit statement: “specific technical reasons are always required.” MPEP § 2164.04 (Emphasis added).

Given these requirements, it is clear that the Examiner has failed to establish a *prima facie* case of lack of enablement. Particularly, the Examiner has not provided any of the required reasoning to base a conclusion that one of ordinary skill in the art would be burdened with undue experimentation to make and use the invention or that the enablement provided by the specification is not commensurate with the scope of protection sought by the claims. In fact, the Examiner provides no lack of enablement analysis whatsoever with respect to the particular recitations of claims 10, 13, and 14. The only claim limitations specifically noted by the Examiner are two “example” limitations of claim 11. Here, the Examiner simply states that the critical components and features called for in all claims are nowhere to be found either in the specification or in the

figures, and to support this assertion, the two “example” limitations of claim 11 are cited as not being supported by the specification. However, in addition to failing to identify any specific essential or critical limitations of claims 10, 13 and 14, the Examiner fails to provide any reasoning as to why one of ordinary skill in the art could not obtain the two example limitations cited from claim 11 without undue experimentation. Furthermore, the two example recitations “specific combined medium programming” and “first” and “second” portions of the specific combined medium programming have been deleted from claim 11. Instead, claim 11 now recites the “method of claim 10, wherein said step of delivering comprises printing said user specific programming at a printer of said interactive mass medium program output apparatus,” which is clearly disclosed and enabled by the detailed description of the Exotic Meals Example in the specification (p. 475, ll. 1-2; see also the description of support for claim 10 in Section II(C)(1)(a) above).

Despite the absence of any reasoned analysis to support the enablement rejection, the Examiner asserts that the burden has shifted to applicants to rebut this challenge. This assertion is clearly incorrect. The burden has not shifted because the Examiner has failed to establish a *prima facie* case of lack of enablement. This is further exemplified by the Examiner’s wholly unsupported allegation that “the disclosure fails to show how the various structures must be interconnected, timed and controlled....” Examiner provides no reasoning to support this conclusory statement. For example there is no mention of what interconnectivity, timing and/or control description is allegedly absent from the disclosure. Moreover, there is no reasoning provided as to why the extensive and detailed disclosure of interconnectivity, timing and control in applicants’ specification is insufficient. Applicants submit that such detailed disclosure is sufficient. For example, in the Exotic Meals Example embodiment of claim 10, the interconnectivity of the relevant components is disclosed on page 470, lines 9-17. The transmission of the programming in the Exotic Meals Example is disclosed on page 478, line 23 - page 480, line 17. The timing is under control of messages described at, e.g., page 428, line 27 - page 479, line 18 and page 480, line 26 - page 481, line 12, et seq. The diagrams supplement these disclosures in, e.g., Figures 7, 7E, and also 2, 2A-C, and 3A.

(For other disclosures of interconnectivity, timing, and control of the invention, see, e.g., Figs. 1, 6A, 6B, 7, & 7E; p. 478, line 23 - p. 480, line 17; p. 535, ll. 18-22; p. 326, line 19 - p. 327, line 8; p. 534, ll. 28-33; p. 536, ll. 11-17; p. 537, ll. 6-17; p. 538, ll. 12-16; p. 539, ll. 20-24; p. 374, line 29 - p. 375, line 6; p. 469, ll. 7 - 17).

In sum, applicants maintain that the Examiner's assertions lack the specific reasoning, and particularly technical reasoning, to support a lack of enablement rejection. Thus, the Examiner has failed to meet his burden to sustain the rejection, and the rejection should therefore be withdrawn. In addition, the Examiner's attention is directed to the detailed support discussion provided above (and in Appendix B) in response to the rejection based on the written description requirement. This support also establishes that applicants' specification is enabling.

## E. Response To Section VI: Section 112, Second Paragraph.

In rejecting the claims under Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention, the Examiner alleges that several terms in the claims are vague and/or indefinite. The Examiner also makes several queries regarding the interpretations of those terms. Applicants address the Examiner's rejections and respond to his queries below. Based on the discussion below, applicants submit that the rejection of the claims under Section 112, second paragraph should be withdrawn.

### 1) Claim 10

Examiner states that claim 10 is vague and indefinite for not providing sufficient antecedent reference for the following terms: "first combined medium programming," "interactive mass medium program," and "said specific combined medium programming" (pp. 64-65). Claim 10 has been amended, and it no longer includes the terms "first combined medium programming" and "said specific combined medium programming." Instead, it includes the terms "mass medium programming" (p. 1, ll. 27-28; p. 470, ll. 2-3 & 9-21) and "user specific programming," which are clear, definite, and supported in the specification (p. 41, line 30 - p. 42, line 1; p. 474, ll. 29-32).

The term "interactive mass medium program" is part of the term "interactive mass medium program output apparatus." It is a physical apparatus which may include the following features: (i) it outputs mass medium programming, such as television programs (p. 469, line 35 - p. 470, line 26); (ii) it has an input device for receiving inputs from subscribers (p. 471, ll. 14-18); (iii) subscribers can enter information at the input device based on the outputted programming (p. 471, ll. 6-17); and (iv) it can deliver programming based on the subscriber input (p. 474, ll. 2-7). The output apparatus is "interactive" at least because it can both output programming and information and receive input based on, e.g., the presented programming. The user input also affects output delivered by the apparatus (p. 471, ll. 6-18; p. 474, ll. 2-7). The term "mass medium" (p. 1, ll. 27-28) refers to its

ability to output mass medium programming, such as television programs (p. 469, line 35 - p. 470, line 23). Applicants submit that this term is clear and that it has sufficient antecedent reference.

**2) Claim 11**

The Examiner states that his arguments regarding claim 10 similarly apply to claim 11. Applicants respectfully submit that applicants' response to the Examiner's rejection of claim 10 similarly applies to claim 11.

The Examiner states that the following terms in claim 11 lack antecedent support: "combined medium programming," "said specific combined medium program," and "said specific combined medium program" (p. 65). The Examiner also requests clarification regarding the terms "generally applicable information" and "first" and "second portion of the combined medium programming," as well as the phrase "for input in respect of a second portion of said specific combined medium programming" (p. 65).

Applicants have amended claim 11, and it now recites, in its entirety, "[t]he method of claim 10, wherein said step of delivering comprises printing said user specific programming at a printer of said interactive mass medium program output apparatus." The subject matter of claim 11, as amended, has sufficient antecedent reference (p. 475, ll. 1-2).

**3) Claims 13 & 14**

The Examiner states that his arguments regarding claims 10 and 11 similarly apply to claims 13 and 14. Applicants respectfully submit that applicants' responses to the Examiner's rejection of claims 10 and 11 similarly apply to claims 13 and 14.

The Examiner further objects to the phrase "outputting for input" in claim 13 (p. 65). This claim has been amended and it no longer includes the phrase "outputting for input." Instead, there are separate outputting and inputting steps, which applicants submit are more clear (p. 470, ll. 9-21; p. 471, ll. 6-21).

The Examiner further objects to the phrase “combined medium programming including computer output” (p. 66). This phrase also no longer appears in any of the claims. Instead, claims 13 and 14 recite the terms “combined medium programming” (p. 12, ll. 30-33), “first combined medium programming” (p. 552, ll. 20-30), and “second combined medium programming” (p. 556, ll. 12-18), which each have sufficient antecedent reference.

Lastly, the Examiner asks “how...mass medium programming and computer programming [are] originated” (66). The claims no longer recite “computer programming,” although they do still recite “mass medium programming.” As stated in the specification, one method of originating programming is described on page 546 of the specification (p. 546, ll. 6-14). The local intermediate station receives a control signal from the national intermediate station that causes the local intermediate station to commence transmitting prerecorded programming to the subscriber stations (p. 556, ll. 6-14; see also p. 546, ll. 19-21 and p. 334, line 34 - p. 335, line 8).

#### **F. Response To Section VII Of The Office Action: Section 102(b).**

##### **1) Saeki Does Not Anticipate The Pending Claims**

Claims 10-11 and 13-14 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,455,570 to Saeki et. al. (hereinafter “Saeki”). Saeki fails to teach or suggest every step of the methods set forth in claims 10-11 and 13-14 for the reasons discussed below.

###### **a) Claim 10**

Claim 10, as amended, is patentable over Saeki because several steps recited in claim 10 are not shown or suggested by the reference. For example, claim 10 requires storing a subscriber’s own information at the interactive mass medium program output apparatus. No such subscriber information is taught or suggested by Saeki. Nor is there any teaching or suggestion in Saeki of how such subscriber information could be used. Claim 10 also requires outputting mass medium programming after the step of storing the subscriber’s own information. This step is not taught or

suggested by Saeki because there is no teaching of a step of storing a subscriber's own information after which such mass medium program would be output. Claim 10 further requires delivering user specific programming based on the stored subscriber's own information. Again, there is no storage of a subscriber's own information taught or suggested by Saeki; therefore, there is no user specific programming based on such stored subscriber's own information disclosed by Saiki.

Accordingly, applicants submit that claim 10, as amended, is fundamentally different and distinguishable from Saeki for at least the above reasons. Applicants therefore respectfully request that the rejection of claim 10 under 35 U.S.C. § 102(b) be withdrawn.

**b) Claim 11**

Claim 11 recites the method of claim 10 "wherein said step of delivering comprises printing said user specific programming at a printer of said interactive mass medium program output apparatus." Saeki does not include a printer apparatus, nor does it teach any kind of printing step.

For at least this reason and the reasons cited above for claim 10, Saeki does not anticipate claim 11.

**c) Claim 13**

Claim 13, as amended, is patentable over Saiki because claim 13 also includes steps not taught or suggested by the reference. For example, claim 13 recites the step of storing the subscriber's own information at the interactive combined medium programming apparatus. Nothing in Saiki teaches or suggests the storage the subscriber's own information, nor does Saiki contemplate any use for that kind of information. Claim 13 also requires outputting first combined medium programming comprising video of general interest and first subscriber specific information. This step is completely absent from Saiki. In the Office action, it appears that the Examiner relies upon the combination of video and audio in Saiki to show combined medium programming. However, claim 13, as amended, clarifies that the combined medium programming comprises first subscriber specific information in addition to video of general interest. This clarified limitation cannot be met

by the simple teaching of video and audio, as nothing about that teaching shows or suggests subscriber specific information. Claim 13 further requires receiving input in response to the first combined medium programming. Since there is no combined medium programming as defined by claim 13 in Saeki, there plainly is no teaching of receiving input in response to such combined medium programming. Claim 13 further requires delivering second combined medium programming that includes second subscriber specific information based on the subscriber's own information and the received input. There is no teaching or suggestion in Saeki of the delivery of subscriber specific information based on the subscriber's own information and input received in response to combined medium programming (as defined in claim 13).

Accordingly, applicants submit that claim 13 is patentable over Saeki for at least the above reasons. Applicants therefore respectfully request that the rejection of claim 13 under 35 U.S.C. § 102(b) be withdrawn.

**d) Claim 14**

Claim 14 recites the method of claim 13 "wherein said step of delivering comprises printing said second subscriber specific information at a printer at said interactive combined medium program output apparatus." As stated above for claim 11, Saeki does not teach a printer or a step of printing.

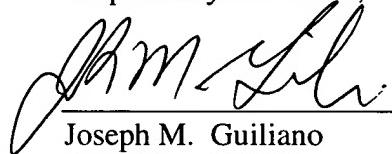
For at least this reason and the reasons cited above for claim 13, Saeki does not anticipate claim 14.

### III. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Respectfully submitted,



Joseph M. Guiliano  
Reg. No. 36,539  
Phone No. 212-596-9000  
Fax No. 212-596-9090

Date: March 5, 2003  
**FISH & NEAVE**  
1251 Avenue of the Americas  
New York, New York 10020